UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2141	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/054,164	KNIGHT, KEVIN J.
	Examiner	Art Unit	
	Kenneth R. Coulter	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>07 June 2007</u>.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>65-99,182-247,249,250 and 252-334</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>65-99,182-247,249,250 and 252-334</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 89 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 89 (dependent upon claim 84) is an identical duplicate of claim 84.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 90 – 94 are rejected under 35 USC 112 second paragraph.

Claim 90 recites the limitation "the first image database" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 228 and 231 – 235 are rejected under 35 USC 112 second paragraph.

Claim 228 recites the limitations "the first webpage" in line 2; "the set of first images" in line 3. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine,
> manufacture, or composition of matter, or any new and useful improvement
> thereof, may obtain a patent therefor, subject to the conditions and requirements
> of this title.

Claims 65 – 89, 95 – 99, 182 – 247, 249, 250, 252 – 258, 262 – 281, 285 – 307, and

312 – 330 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

Independent claims 65, 73, 80, 85, 182, 196, 203, 210, 217, 236, 240, 262, 285, 286,

290, 294, 300, 304, 316, 321, 324, 326, and 328 are directed to methods that can be

interpreted as programs.

Independent claims 95 and 312 utilize means plus function language that can be

interpreted as being strictly software instructions.

Data structures not claimed as embodied in computer-readable media are descriptive
material *per se* and are not statutory because they are not capable of causing functional
change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760
(claim to a data structure *per se* held nonstatutory). Such claimed data structures do
not define any structural and functional interrelationships between the data structure
and other claimed aspects of the invention which permit the data structure's functionality
to be realized. In contrast, a claimed computer-readable medium encoded with a data

structure defines structural and functional interrelationships between the data structure
and the computer software and hardware components which permit the data structure's
functionality to be realized, and is thus statutory.

Tangible hardware can be added to these independent claims in order to overcome the

35 USC 101 rejection.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

2.   Claims 65 – 99, 182 – 247, 249, 250, and 252 – 334 are rejected under 35

U.S.C. 102(e) as being disclosed by Berger et al. (U.S. Pat. No. 6,414,693) (System

and Method for Generating Computer Displays of Custom Bag Designs).

2.1   Regarding claim 65, Berger discloses a method for generating a composite

image including:

      presenting a first image via a Web interface presented on a browser (Abstract;

Figs. 1, 3; col. 1, line 66 – col. 2, line 20; col. 3, lines 40 – 52);

presenting a second image via a Web interface presented on the browser

(Abstract "Each client is associated with one or more profile, and each profile includes a

series of images associated therewith"; Figs. 1, 2, 3, 4; Fig. 6, item 608; col. 4, lines 6

– 25; col. 1, line 66 – col. 2, line 20);

communicating a selecting of the first image and the second image to a server

via a network (Abstract "selects desired article images"; Fig. 3; col. 2, lines 14 – 20);

automatically generating a composite image of the first image and the second

image at the server (Abstract; Fig. 3; col. 2, lines 14 – 24); and

communicating the composite image from the server to the browser via the

network (Abstract; Figs. 1, 3, 7; col. 2, lines 14 – 26).

2.2   Per claim 66, Berger teaches that the first image is a product image (Title

"Custom **Bag** Designs"; Abstract; Figs. 1, 3, 7; col. 1, line 66 – col. 2, line 20; col. 3,

lines 40 – 52).

2.3   Regarding claim 67, Berger discloses that the second image is a decorative

image including any one of a group of images including logo image and a text image

(Abstract "Each client is associated with one or more profile, and each profile includes a

series of images associated therewith"; Figs. 1, 2, 3, 4; Fig. 6, item 608; col. 4, lines 6

– 25; col. 2, lines 24 – 28 "while the graphics are **logos**, tradenames, **pictographs**,

etc.").

2.4   Per claim 68, Berger teaches that the composite image includes the second

image placed in a default position on the first image (Fig. 9; col. 7, lines 44 – 46 "the

graphic 802 has been positioned within the relative center of the bag 702").

2.5   Regarding claim 69, Berger discloses:

positioning the second image relative to the first image via a Web interface

presented on the browser to generate relative positioning information (Fig. 9; col. 7, line

44 – col. 8, line 20);

communicating the relative positioning information to the server via the network

(Fig. 9; col. 7, line 44 – col. 8, line 20); and

automatically generating the composite image of the first image and the second

image at the server according to the relative positioning information (Fig. 9; col. 7, line

44 – col. 8, line 20).

2.6   Per claim 70, Berger teaches that the composite image is associated with

information in a database, the associated information in the database being

communicated together with the composite image from the server to the browser via the

network as a photo sample (col. 6, line 48 – col. 7, line 15 "JPEG-format file"; col. 2,

lines 24 – 28 "while the graphics are logos, tradenames, **pictographs, etc.**").

2.7   Regarding claims 71 and 72, Berger does not explicitly disclose that the photo

sample is sent via network to a specified email address; or teach a URL, containing the

photo sample that is sent via network to a specified email address.

It would have been inherent to implement the sending of photo information via email

because Berger clearly discloses an Internet based system (col. 1, lines 6 – 9) for

downloading and uploading information through a browser. Email attachments are

notoriously well known avenues for delivery of photo information over the Internet.

2.8   Regarding claims 73 – 99, 182 – 247, 249, 250, and 252 – 334, the rejection of

claims 65 – 72 under 35 USC 102(e) (paragraphs 2.1 – 2.7 above) applies fully.

In addition Berger discloses normalizing dimensions of images (col. 6, line 48 – col. 7,

line 15).

Also, Berger teaches two separate memory storage areas (libraries) for storage of the

superimposed data (Fig. 1, items 130, 122; col. 3, lines 38 – 58).

In addition, Berger discloses first and second parameters that define particular colors for

first and second images (col. 8, lines 20 – 42 "enables end users to view completed

bags with desired graphics thereon quickly, easily and in **a large number of**

variations." "applications that allow certain portions of the graphic to be in-filled with

alternate colors …"; col. 7, lines 9 – 18 "color combinations").

3.   Claims 65 – 99, 182 – 247, 249, 250, and 252 – 334 are rejected under 35

U.S.C. 102(e) as being disclosed by Bornstein (U.S. Pat. No. 6,144,388) (Process For

Displaying Articles of Clothing on an Image of a Person).

3.1   Regarding claim 65, Bornstein discloses a method for generating a composite

image including:

        presenting a first image via a Web interface presented on a browser (Fig. 4; col.

16, line 55 – col. 17, line 25);

        presenting a second image via a Web interface presented on the browser (Fig. 4;

col. 16, line 55 – col. 17, line 25);

        communicating a selecting of the first image and the second image to a server

via a network (Fig. 4; col. 16, line 55 – col. 17, line 25);

        automatically generating a composite image of the first image and the second

image at the server (Figs. 4 and 6B; col. 16, line 55 – col. 17, line 25); and

        communicating the composite image from the server to the browser via the

network (Fig. 4; col. 16, line 55 – col. 17, line 25).

3.2   Per claim 66, Bornstein teaches that the first image is a product image (col. 16,

line 61 – col. 17, line 5).

3.3   Regarding claim 67, Bornstein discloses that the second image is a decorative

image including any one of a group of images including logo image and a text image

(col. 14, line 39 "text objects").

3.4   Per claim 68, Bornstein teaches that the composite image includes the second

image placed in a default position on the first image (Fig. 10A; col. 26, lines 3 - 10).

3.5   Regarding claim 69, Bornstein discloses:

        positioning the second image relative to the first image via a Web interface

presented on the browser to generate relative positioning information (col. 19, lines 46 -

58);

        communicating the relative positioning information to the server via the network

(col. 19, lines 46 - 58); and

        automatically generating the composite image of the first image and the second

image at the server according to the relative positioning information (col. 19, lines 46 -

58).

3.6   Per claim 70, Bornstein teaches that the composite image is associated with

information in a database, the associated information in the database being

communicated together with the composite image from the server to the browser via the

network as a photo sample (Figs. 1, 4; col. 1, lines 19 – 20; col. 17, lines 27 – 32 and 55

- 59).

3.7   Regarding claims 71 and 72, Bornstein does not explicitly disclose that the photo
sample is sent via network to a specified email address; or teach a URL, containing the
photo sample that is sent via network to a specified email address.

It would have been inherent to implement the sending of photo information via email
because Bornstein clearly discloses an Internet based system (Fig. 4) for downloading
and uploading information through a browser. Email attachments are notoriously well
known avenues for delivery of photo information over the Internet.

3.8   Regarding claims 73 – 99, 182 – 247, 249, 250, and 252 – 334, the rejection of
claims 65 – 72 under 35 USC 102(e) (paragraphs 3.1 – 3.7 above) applies fully.

In addition Bornstein discloses normalizing dimensions of images (col. 19, lines 46 -
58).

Also, Bornstein teaches two separate memory storage areas (libraries) for storage of
the superimposed data (Fig. 4, items 114 and 116; col. 16, lines 55 – 64 "models
database"; col. 17, lines 19 – 39 "user's picture database").

In addition, Bornstein discloses first and second parameters that define particular colors
for first and second images (col. 22, lines 11 – 21).

Response to Arguments

Applicant's arguments filed 6/7/07 have been fully considered but they are not persuasive.

Applicant argues that Bornstein does not explicitly disclose "communicating a selecting of the first image and the second image to a server via a network."

Examiner disagrees.

This item is clearly shown in Figure 4 and in the specification of Bornstein (col. 16, line 55 – col. 17, line 26).

Clearly, more than one picture of a single user can be stored and referenced (selected) in Bornstein.

Applicant argues that "there is no need to select from a plurality of user images, since each user is capable of supplying its own image …".

Examiner disagrees.

Figure 4 clearly shows in item 116 a separate database that contains user's information, including a user's 2D picture. This database contains the images of multiple users and "**one or more pictures of the user** or another person." (col. 17, lines 19 – 26).

Clearly, more than one picture of a single user can be stored and referenced (selected) in Bornstein.

Applicant states that there is no disclosure in Bornstein of a "logo image."

Examiner disagrees.

Bornstein discloses that the second image is a decorative image including any one of a group of images including logo image and a text image (col. 14, line 39 "text objects").

The remaining arguments are answered in the 35 USC 102(e) rejection above (paragraphs 3.1 – 3.8).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/
Primary Examiner, Art Unit 2141

krc